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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,288	04/07/2000	Stephane Ayala	032326-057	1602

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EXAMINER

TRINH, MINH N

ART UNIT PAPER NUMBER

3729

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/545,288

Applicant(s)

AYALA ET AL.

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-24,27,29 and 40-46 is/are pending in the application.
- 4a) Of the above claim(s) 6-12,27,29 and 40-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 14-23 is/are rejected.
- 7) ☒ Claim(s) 4,13 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/13/06 has been entered.

### ***Election/Restrictions***

2. Newly submitted claims 40-46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

a) First, that claims 40-44 are directed to a product and the product does not necessary to be made by another process instead of the process invention as original claimed. Note that the Office generally does not permit shift of elected subject matter (see section 819 of the MPEP). Further, Inventions as originally claimed versus claims 40-44 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process invention as originally claimed can be used to make another and materially different product instead of the smart card of claims 40-44 such as other

electronic signaling device i.e., wireless antenna or an RFID tag, etc. Further, the product can be made by another and materially different process instead of process as originally claimed where the use of the solder reflow for connecting the antenna to the pads, etc.

c) Further, claims 45-46 is also directed to an invention that is independent or distinct from the invention originally claimed for the following reasons. Because Inventions are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination claims 45-46 as claimed does not require "the connecting at least one ends of the antenna to a respective pad by means of an insulation bridge disposed on a surface of the turn that is away from the support sheet", etc., as required by the invention as originally claimed. . The subcombination has separate utility such as for connecting an end of the antenna or connection pad to an electronic module, etc. It is also noted that inventions above have different mode of operations, functions and/or effects. See MPEP § 806.05(d). Accordingly, claims 40-46 are withdrawn from consideration as being drawn to the non-elected inventions (see reasons set forth above).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 40-46 are withdrawn from consideration as being directed to non-elected inventions. See 37 CFR 1.142(b) and MPEP § 821.03.

3. An Office action on the merits of elected claims 1, 2, 4, 13-24 as follows (note that only claims 1, 2, 4, 13-24 are readable on the elected species 1A, 2A, 3A and 4D). Thus, claims 6-12, 27 and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species inventions (species 1B, 2B, 3B, and 4A, 4B, 4C), there being no allowable generic or linking claim (see applicants' reply filed on 10/25/04).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Fidalgo (5,598,032).

Fidalgo discloses a method for manufacturing smart card having at least two turn antenna 5, connection pads 15 on a support sheet 3, an insulating bridge 6 so as to connect each of the ends of the antenna to at least one of connection pads respectively (see Figs. 1-3 and the discussion at col. 3, lines 35-36). It is noted that reference 6 broadly read on an insulation bridge as claimed by the present invention.

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As applied to claim 2, Noting each of related Fidago's Figs. 1-3 depicts the insulation being covering antenna 5 turns and the forming of a conductive element on the insulation layer in one zone (see the discussion at col. 3, lines 64-to col. 4, line 5).

As applied to claim 14, Fidago discloses the method recited in claim 14 including connection pads and the module, it is inherent to use low melting solder for connection module to the antenna (refer col. 6, lines 1-5).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fidago.

As applied to claims 15-20, it would have been obvious to one having skill in the art to incorporate use of particular materials as recited in these claims since it was known in the art that selecting a material from a host of group of available materials on the basis of its suitability for the intended use as a matter of obvious design choice.

Limitations of claims 16-20 are similar to that as discussed above.

As applied to claims 21-23, it would have been an obvious matter of design choice to choose any desired means for connection between the connection pads of the antenna and the conductive pads of the module including the use of grease charged,

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silicon gasket charged, and/or additional gold deposited by thermal compression since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the conventional bonding techniques as taught by each of the prior art reference ( i.e., see the discussion of Fidago at cols. 5-6).

### ***Allowable Subject Matter***

8. Claims 4, 13 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of method of manufacturing chip card or smart card devices.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mt  
4/26/06

  
MINH TRINH  
PRIMARY EXAMINER